

**I N T H E U N I T E D S T A T E S
P A T E N T A N D T R A D E M A R K O F F I C E**

Inventors: David Gray Boyer et al.

Serial No.: 10/672633

Conf. No.: 8084

Filing Date: 09/26/2003

Art Unit: 2617

Examiner: Mehrpour, Naghmeh (Melody)

Docket No.: 633-061US

Title: Method and apparatus for delivering a voice mail message with an indication of the presence of the sender

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL-BRIEF REQUEST FOR REVIEW

The applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

Respectfully,
David Gray Boyer et al.

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**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

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Dear Sir:

PRE-APPEAL-BRIEF REMARKS

This paper is in response to the *Final Office Action* that issued in this case on 7 April 2011 and is further accompanied by a *Notice of Appeal/Pre-Appeal Brief Request* for review. The applicants submit that the cited prior art omits essential limitations needed for a *prima facie* rejection. As such, the applicants respectfully request a panel review of the application.

35 USC § 103 Rejection of Independent Claims 1-8, 11-13, and 16-24

Claims 1-8, 11-13, and 16-24 were rejected under 35 USC § 103 as being obvious over the combination of US Patent No. 7,447,495 (hereinafter "Agrawal") and *Official Notice*. The applicants traverse the Examiner's rejection for at least the reasons discussed below.

Independent claim 1 recites:

1. A method for delivering a voice mail message to a recipient, comprising:
receiving said voice mail message from a sender;
obtaining a presence status of said sender from a presence server;
delivering said voice mail message to said recipient with an indication of a presence of said sender, said indication including an identification of at least one device where said sender is present.
(emphasis supplied)

For a brief discussion regarding the illustrative embodiment of the present invention, as defined by the limitations recited in claim 1, the applicants respectfully direct the panels' attention to page 6 of the *Response* filed on 7 March 2011.

At page 3 of the present Action, the Examiner states that Agrawal fails to teach or suggest the limitation of "*receiving [a] voice mail message from a sender*" recited in claim 1.

To cure the deficiencies of Agrawal, the Examiner states "[h]owever, the Examiner takes official notice that receiving voice mail instead of **e-mail** is a well feature in the art."

It is not understood by the applicants why the Examiner is making reference to e-mails in her Official Notice when the invention of Agrawal pertains to instant messages.

Instead, it is believed that the Examiner intended to take Official Notice that "*receiving a voice mail instead of an instant message is a well-known feature in the art.*"

Nevertheless, the applicants disagree with both the stated and the intended Official Notices for at least the reasons discussed below.

First: As stated in the Response filed on 7 March 2011, it is well-known in the art that a voice mail stored at a server can incur a significant amount of delay between the time of transmission and the time of listening to the voice mail. Because the sender may not be present at the transmitting terminal when the recipient listens to the voice mail, the problem of determining the best mode and type of communications to use when responding to the voice mail arises.

In this regard, the novel feature of the present invention is not whether a server delivers a "voice mail" or an "instant message" to a recipient (as alluded to by the Examiner's Official Notice), but rather, the server delivers the voice mail to a recipient **with** an indication of the sender's presence information. This novel and non-obvious feature recited in claim 1 addresses the problem, above, of determining the best mode and type of communications to use when a recipient responds to a voice mail.

As stated by the Examiner, Agrawal does not teach or suggest (1) receiving a **voice mail** from a sender and (2) delivering a **voice mail** to a recipient. The applicants agree. The applicants however disagree with the Examiner's contention that the Official Notice cures the deficiencies of Agrawal, as further discussed below.

As best understood, the Examiner's Official Notice suggests that it would have been obvious to a person skilled in the art to substitute Agrawal's instant message with a voice mail.

Even if this was true, Agrawal does not provide any teaching, suggestion, or motivation that a server delivers a sender's presence information **with** an instant message/voice mail to an intended recipient.

Further, Agrawal does not teach or suggest that the presence information delivered to the recipient **includes** an identification of at least one device where the sender is present.

According to Examiner, the above features are disclosed at col. 6, line 64 – col. 7, line 10 and col. 8, lines 46-64 of Agrawal. (see, Final Office Action at pages 2,3, and 6). The applicants disagree.

Col. 6, line 64 – col. 7, line 10 of Agrawal discloses that "*a buddy list can be presented to an instant messaging user to identify members of the buddy list that are currently available. Alternatively, user presence data can be configured to indicate when a user will become available, or if a user is reachable, but not currently available. User presence data can be configured to provide alerts as users log on or off an application such as an instant messaging application, or designate an address for message delivery. For example, user presence could indicate that a user is available by cell phone and currently unavailable by desktop. In addition, user presence data can include cell phone status such as data or voice mode indications and applications configured to transmit messages appropriately.*"

The underlined portion, above, is used by the Examiner as a basis for rejecting the limitation in question. This excerpt from Agrawal at best teaches that a buddy list is presented to an instant messaging user to identify members of the buddy list that are currently available. The presence data of Agrawal's buddy list can be configured to indicate that a member of the buddy list is available by cell phone and unavailable by desktop.

However, **nothing** in the above excerpt from Agrawal teach or suggest that a server delivers a sender's presence information **with** an instant message/voice mail to an intended recipient — much less motivate such a limitation. Moreover, nothing in the excerpt from Agrawal suggests or motivates that the presence information delivered to a recipient **includes** an identification of at least one device where the sender is present.

Turning to col. 8, lines 46-64, Agrawal discloses that "*[i]n a representative example, user actions based on a selected application (such as instant messaging, word processing, email, data communication, voice messaging) can be used to establish or update user activity status data. Such user activity status data is associated with network actions by the user*

based on actual network use by the user. Communication with other users and/or with applications can be based on user activity status data."

The underlined portion, above, is also used by the Examiner as a basis for rejecting the limitation in question. However, this excerpt from Agrawal discloses nothing more than employing user actions as a means for **updating** a user activity status data. Nothing in the above excerpt suggests or motivates that a server delivers a sender's presence information **with** an instant message/voice mail to an intended recipient.

Furthermore, to the extent that Agrawal teaches "presence information," the presence information is stored at a "presence server" and not delivered to a recipient. The presence information stored at the presence server is used by an "instant message application server" to determine how to process an instant message received from a sender. Based on the presence information stored at the presence server, the application server forwards, returns, stores, or discards the instant message. (see, Agrawal at col. 5, lines 23-52).

In contrast to Agrawal, and the Examiner's interpretation of the cited passages, claim 1 requires that a server receive a voice mail from a sender, obtain presence information of the sender from a presence server, and deliver the voice mail to an intended recipient **with** the sender's presence information, wherein the presence information **includes** an identification of at least one device where the sender is present.

Second: The Examiner states that the motivation to combine Agrawal and the Official Notice is "*in order to notify the user of the incoming telephone call in response to the telecommunication interface intercepting the incoming telephone call prior to ringing of the incoming telephone call.*" (see, Final Office Action at pages 3 and 4). It is submitted that the Examiner's motivation to combine Agrawal and the Official Notice is unreasonable.

First, what "*incoming telephone call*" and what "*telecommunications interface*" is the Examiner referring to? It is unclear how the Examiner's above reasons would motivate a person skilled in the art to combine the teachings of Agrawal and the Official Notice to arrive at the determination of obviousness. The present invention pertains to delivering a voice mail to a recipient with a sender's presence information and **not** "*notifying [a] user of [an] incoming telephone call ... prior to ringing of the incoming call,*" to quote the Examiner.

Second, the motivation to combine is unsupported by Agrawal — that is, Agrawal does not teach or suggests the Examiner's modification, let alone motivate such a modification. (see, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

Clearly, the Examiner is using the applicants specification as in instruction manual and a template as a means to read limitations into the prior art reference that are neither taught nor suggested by Agrawal — i.e., **hindsight** construction.

In view of the foregoing reasons, Agrawal and the Official Notice do not teach or suggest the limitations recited in claim 1, whether considered individually or in combination. As a consequence, the applicants respectfully request the panel to reverse the Examiner's rejection of claim 1. Because claims 2-11 depend on claim 1, the applicants respectfully request the panel to reverse the Examiner's rejections of these dependent claims as well.

Independent claim 12: In addition to being allowable for the reasons presented above, claim 12 recites additional patentable features that are neither taught nor suggested by Agrawal and the Official Notice, whether considered individually or in combination.

In particular, the Examiner asserts that Agrawal discloses providing a mechanism for a recipient to **automatically respond to a sender** at a device where the sender is believed to be present, citing to col. 8, lines 52-56 of Agrawal. The applicants disagree.

This passage from Agrawal cited by the Examiner at best discloses that a user's interaction with an instant messaging application, a word processing application, an e-mail application, and a voice messaging application can be used to **update** the user's presence and availability status. However, nowhere does Agrawal disclose providing a mechanism for a recipient to **automatically respond to a sender** — let alone, automatically respond to the sender at a device where the sender is believed to be available.

In view of the foregoing reasons, Agrawal and the Official Notice do not teach or suggest the limitations recited in claim 12, whether considered individually or in combination. As a consequence, the applicants respectfully request the panel to reverse the Examiner's rejection of claim 12. Because claims 13-16 depend on claim 12, the applicants respectfully request the panel to reverse the Examiner's rejections of these dependent claims as well.

Independent claim 17: Claim 17 is allowable over Agrawal and the Official Notice for essentially the same reasons as claim 1, above. As a consequence, the applicants respectfully request the panel to reverse the Examiner's rejection of claim 17. Because claims 18-24 depend on claim 17, the applicants respectfully request the panel to reverse the Examiner's rejections of these dependent claims as well.